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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,646	01/13/2006	Hitoshi Kokumai	19A 3812 PCT	1674
<div>7590 10/14/2010 Quinn Emanuel Urquhart Oliver &amp; Hedges, LLP Koda/Androlia 865 S.Figueroa Street, 10th Floor Los Angeles, CA 90007</div>				
EXAMINER				
KANAAAN, SIMON P				
ART UNIT		PAPER NUMBER		
2432				
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10/14/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/564,646

**Applicant(s)**

KOKUMAI ET AL.

**Examiner**

SIMON KANAAN

**Art Unit**

2432

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-12 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-12 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/23/2010 has been entered.
2. Applicant's arguments/ amendments with respect to pending claims 10 through 12 and 21 filed 08/23/2010, have been fully considered but are moot based on new grounds of rejection as which were necessitated by examiner's amendment.

**Claim Rejections - 35 USC § 101**

3. 35 U.S.C. 101 reads as follows:  
  
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
4. Claims 10-12 and 21 are rejected under 35 U.S.C. 101 as directed to non-statutory subject matter.

As per claim 10-12 and 21, the applicant discloses that the "recording medium" includes "electronic medium" which would include signals. As defined by the courts, signals do not fall within any of the four statutory categories of invention, see *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007). Clarification by applicant is requested as to what is meant to be encompassed by "recording medium". Examiner recommends changing the limitation to "non-transitory computer recording medium".

**Claim Rejections - 35 USC § 112**

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 10-12 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per Claims 10-12 and 21, recite the elements "recording means", "determining means" and "generating means" which are a means (or step) plus function limitations that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function.

Applicant is required to:

- (a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or
- (b) Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or
- (c) State on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

For a computer-implemented means-plus-function claim limitation that invokes 35 U.S.C. 112, sixth paragraph, the corresponding structure is required to be more than simply a

general purpose computer or microprocessor. The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer or microprocessor.

**Claim Rejections - 35 USC § 103**

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honarvar et al. (US Pre-Grant Publication No: 2003/0154406 A1) hereinafter Honarvar, in view of Moto Eitetsu (JP 2002358418(A)) hereinafter Eitetsu.

As per claim 10, Honarvar discloses an individual authentication system using a recording medium, the recording medium being constituted by a memory function by using an electronic device in which a memory function is built, the memory function having functions of: registration information recording means which registers both user information including at least one information unit known by a user to be registered in authentication and non-user information including at least one information unit unknown by the user for user authentication in the recording medium in advance to record registration information; - Honarvar, [0024]-[0025], teaches using personal history which would be user information known to the user as well as geographic information which would be information unknown to the user which is stored.

and access information recording means which record access information given the user, comprising an authentication computer having: access information comparison determining means which confirms, when a user candidate inputs access information, that the access information is the access information given to the user candidate in user authentication; registration presenting means which outputs the registration information recorded on the registration information recording means on the bases of generation of a confirmation signal from the access information determining means; user information determining means which compares input user information selected from the presented registration information with the recorded user information for authentication; - Honarvar, figure 37, teaches determining which pieces of information to use to authenticate the user

an authentication signal generating means which generates an authentication signal to the electronic device in which the recording medium is built on the bases of authentication determination of the user information determining means to permit the user to use the electronic device; - Honarvar, figure 37, teaches authenticating the user which would generate an authentication signal once the information input is correct

and wherein the user information is selected from visual information which user contacts for a long period of time in an episode memory of the user; - Honarvar, [0024]-[0025], teaches storing information for authentication which include personal history which would be episodic memory

But Honarvar does not teach at least one of the user information is an information unit for unwilling authentication signal used when user authentication is performed despite the intention of the user.

However Eitetsu teaches one of the user information is an information unit for unwilling authentication signal used when user authentication is performed despite the intention of the user. -Eitetsu, abstract, teaches having multiple passwords for authenticating where a user may use an emergency password which triggers an emergency procedure if user is forced to authenticate but wishes not to authenticate using his normal non-distressed password.

It would have been obvious at the time of the invention to modify the modify the password generation verification method of Honarvar with the emergency password verification method of Eitetsu since it would be desirable for some applications such as ATM machines to have an emergency password to use if the user is forced to authenticate unwillingly but desires a different outcome than there normal non-distressed authentication.

As per claim 11, Honarvar in view of Eitetsu discloses the individual authentication system using a recording medium according to claim 10, wherein the non-user information is non-user information synthesized on the basis of the user information. - Honarvar, [0024]-[0025] and figure 37, teaches using multiple questions for authentication hence multiple passwords are needed for authentication which is multiple pieces of information synthesized.

As per claim 12, Honarvar in view of Eitetsu discloses the individual authentication system using a recording medium according to claim 10, wherein pieces of individual registration information and pieces of access information are held. - Honarvar, [0024]-[0025], teaches storing multiple pieces of information for authentication.

9. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Honarvar in view of Eitetsu and further in view of Pering et al. (US patent No: 7,174,462 B2) hereinafter Pering.

As per claim 21, Honarvar in view of Eitetsu discloses the individual authentication system using a recording medium according to claim 10, but does not disclose wherein said visual information is selected from the group consisting of photographs, pictures, and drawings.

However, Pering teaches wherein said visual information is selected from the group consisting of photographs, pictures, and drawings. -Pering, figure 2, teaches choosing a password from of a photograph.

It would have been obvious at the time of the invention for one of the ordinary skill in the art to modify the user verification method of Honarvar with using pictures for authentication of Pering because it makes it easier on the user to authenticate. -Pering, column 2, lines 16-20.

### **Conclusion**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon Kanaan whose telephone number is (571) 270-3906. The examiner can normally be reached on Monday to Friday 8:30 AM to 5:00 PM.

If attempts to reach the above noted Examiner by telephone are unsuccessful, the Examiner's supervisor, Gilberto Barron, can be reached at the following telephone number: (571) 272-3799.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained



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from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/SIMON KANAAN/  
Examiner, Art Unit 2432

/Benjamin E Lanier/  
Primary Examiner, Art Unit 2432